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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,311	11/12/2003	Ken Rosenblum	1326.007US1	9674
21186 7590 06/27/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
SHAPIRO, JEFFERY A				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
06/27/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/706,311

**Applicant(s)**

ROSENBLUM, KEN

**Examiner**

JEFFREY A. SHAPIRO

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-549)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/17/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-15 and 21-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Bain (US 2005/0021175A1).

As described in **Claims 1-3, 5, 6, 13-15, 21, 23 and 24**, Bain discloses an automatic medication dispensing machine (100) having a loading portion facing an enclosed pharmacy floor space, as shown in figure 2, the pharmacy, being to the right of wall (104). Service providers on the right side place filled prescriptions into compartments (152) which are closed by doors (166). A customer keys in a PIN number and phone number at the front console data interface (124) which is mentioned in paragraph 60 as having a keyboard. See also paragraph 111. If the phone number and PIN are verified, and the customer verifies the order listed on the screen, then the dispensing mechanism releases the filled prescription through door (158) to pick up area (140).

Further regarding **Claim 6**, note that Bain discloses that the prescriptions are verified at paragraph 111.

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Bain further discloses, as described in **Claim 4**, a bar code reader (78).

Bain also discloses, as described in **Claims 7, 8, 25 and 26**, a speaker (32) and a video device described in paragraphs 20 and 43.

Regarding **Claim 9**, Bain discloses a remote communications means (86) that is described in paragraphs 52-58 that allows delivery of a filled prescription to a customer located outside the store.

Regarding **Claims 10 and 27**, see paragraph 111, which describes the financial transaction that takes place during a dispensing event.

Regarding **Claim 11**, Bain discloses a dispensing mechanism (100), a product delivery chute having a product holding portion (152) and a product holding portion (140) separated by moving door (158).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bain in view of Coughlin et al (US 6,883,681 B1).

Bain discloses the drug will-call system described above.

Williams does not expressly disclose, but with respect to Claim 22, Coughlin discloses shelf storage locations (16) with an infeed conveyor (18) and an outfeed

conveyor (21) with a pick and place transporter (22 and 126) that transports items between the storage locations and the infeed and outfeed conveyors.

Williams does not expressly disclose, but with respect to Claim 12, Coughlin discloses a ram assembly (90) for pushing products from the infeed conveyor to the transporter, said ram assembly having a sensor (100) that senses when product has been conveyed in front of the ram plate (92). See figures 8-12 and col. 6, lines 16-33. Coughlin also discloses a ram assembly (118) which moves items onto outfeed belt (110). See figures 13-17 and col. 6, line 35-col. 7, line 12.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have added Coughlin's transporter to transport items from Bain's storage areas to Bains dispensing area and to have incorporated Coughlin's conveyor with ram assembly into Bain's dispensing area. to push items to and from the conveyor to the transporter or vise-versa.

The suggestion/motivation for using Coughlin's transporter would have been to transport items efficiently to and from Bain's storage areas to the dispensing area. The suggestion/motivation for using Coughlin's conveyor with ram assembly in Bain's dispensing area would have been to push items back and forth from the conveyor to the transporter.

Note that one ordinarily skilled in the art would have found it obvious to use a time out based on the output of sensor (100), for example, thus causing ram assembly (90) to clear the dispensed items from the dispensing area, as suggested by Coughlin's ram assemblies (90) and (118).

Also, note that one ordinarily skilled would have found it obvious to make Bain's compartments more horizontal so as to work with Coughlin's transporter.

See also Coughlin at col. 13, lines 1-5, which describes the infeed conveyor moving several items back from the ram leaving only one item in front of the ram during a particular event, such as receiving a command to load an item during a storing routine. This can be construed as further motivation for one ordinarily skilled to cause items left on the outfeed dispensing conveyor to be cleared and restored in one of the storage compartments.

### ***Response to Arguments***

8. Applicant's arguments filed 3/17/08 have been fully considered but they are not persuasive. Applicant's newly added claim limitations where "the customer request include[s] a one-time use, unique code, which is ~~incapable of being reused~~ specific to the prescription being filled", are recited in Claims 1, 13 and 21. As discussed above, Bain discloses use of a "personal pin number" at paragraph 111. Applicant asserts that the Bain's patient's personal identification number (PIN) is not a one-time use unique code. However, note that the term "one-time use" can be met by Bain since Bain's pin number is capable of not being reused if the user so intends by simply not using it.

If the customer uses Bain's machine once each day and changes the pin periodically, such as after each use, the customer will then have a new pin number each day and after each use. Additionally, the new limitations requiring the unique code to be specific to the prescription being filled is met by Bain because, as is clearly stated in paragraph 11 of Bain, the system asks the customer to enter his personal pin number,

and if the phone number and pin match, the prescription number is displayed. Thus, Bain's pin number is directly linked to the customer's prescription number and is therefore specific to that prescription number and therefore the prescription being filled at the particular time the customer is using the pin to access said prescription number. Thus, Applicant's claim language in Claims 1, 13 and 21 directly read on Bain's disclosed pin number that a customer uses to access his prescriptions in Bain's machine.

### ***Conclusion***

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY A. SHAPIRO whose telephone number is (571)272-6943. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick H. Mackey can be reached on (571)272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Shapiro/  
Primary Examiner, Art Unit 3653

June 23, 2008